

REMARKS

Claims 1-8, 10, and 13-20 remain pending in the application. Claims 9 and 11 have been canceled without prejudice or disclaimer. Claims 1, 3, 6, 8, 10, 13, and 19 have been amended without introduction of new matter. Favorable reconsideration is respectfully requested in view of the above amendments and the following remarks.

Claims 1-7 and 10-18 stand rejected under 35 U.S.C. §101 as allegedly not defining a statutory process because they are not tied to a particular machine and do not transform underlying subject matter to a different state or thing. This rejection is respectfully traversed.

The rejection of claim 11 has been rendered moot by the cancellation of this claim without prejudice or disclaimer.

In response to the rejection of the remaining claims 1-7, 10, and 12-18, independent method claim 1 has been amended to define, *inter alia*, “one or more automated Issuer hardware components providing a personal account number ..., wherein the step of providing the personal account number further comprises the one or more automated Issuer hardware components using automated data transmission techniques to provide the personal account number to one or more hardware components of a Personal Account Number (PAN) Facilitator, wherein the PAN Facilitator is a single technology supplier capable of interacting with a plurality of Issuers.” Support for the one or more automated hardware components can be found in the specification at, for example, page 16, lines 2-8. Support for the use of automated data transmission techniques can be found in the specification at, for example, page 16, lines 12-14.

Similarly, independent method claim 10 has been amended to define, *inter alia*, “providing a card, the card being tangible and having a front side and a back side” and “using automated equipment to read the machine readable information and to use the machine readable information in a card activation procedure.” Support for the card being tangible can be found at least by the plain meaning of the original term “card”, and can further be found in the specification at, for example, page 16, lines 20-26 which recite numerous tangible embodiments of cards. Support for the newly added step can be found in the specification at, for example, page 18, lines 19-27.

Dependent claims 2-7 and 12-18 inherit these respective features as well. In addition, dependent claim 6 has been amended to define, *inter alia*, “communicating the personal account number and a proposed transaction to the Issuer by means of an automated credit

and/or debit authorization infrastructure.” Support for this amendment can be found in the specification at, for example, page 11, lines 23-28.

In view of the above amendments, each of the method claims is believed to define a statutory process at least because each is tied to a particular machine. Accordingly, it is respectfully requested that the rejection of claims 1-7, 10, and 12-18 under 35 U.S.C. §101 be withdrawn.

Claims 8-9 and 19-20 stand rejected under 35 U.S.C. §101 as allegedly defining non-statutory subject matter. This rejection is respectfully traversed.

The rejection of claim 9 has been rendered moot by the cancellation of this claim without prejudice or disclaimer.

As to the remaining claims 8 and 19-20, the Office’s conclusion is based on its allegation that “the apparatus and system claims 8 and 19 are directed to software, per se (e.g. a machine readable information), which do not fall within one of the four statutory classes of invention.”

It is respectfully submitted that the Office has erred in its analysis by failing to read each claim as a whole. Neither of claims 8 and 19 defines only “machine readable information.” Rather, original independent claim 8 defined a combination of elements, including “a card, the card having a front side and back side.” The claim goes on to define various elements that are included on the card, such as “machine readable information on at least one of the front side and back side” and “account information indicia on at least one of the front side and back side” (emphasis added).

Applicants can think of no reasonable interpretation of the term “card having a front side and back side” that is not tangible. Therefore, the claim as a whole cannot cover “software per se”, as alleged by the Office, and no claim amendment is believed to be necessary to overcome this rejection. Nonetheless, in order to expedite favorable prosecution of the application, each of claims 8 and 19 has been amended to further define “the card being tangible.” Support for this amendment is believed to exist at least by the plain meaning of the original term “card”, and can further be found in the specification at, for example, page 16, lines 20-26 which recite numerous tangible embodiments of cards. Claim 19 has further been amended to define “a personal account number facilitation system comprising one or more hardware components” and “a redemption sit interface ... operative to connect by means of automated data transmission techniques” (emphasis added). Support for these

amendments can be found in the specification at, for example, page 16, lines 2-8 and page 16, lines 12-14, respectively.

In view of the amendments there is no possibility that either of claims 8 and 19 is directed to nothing but “software per se” at least because each includes at least one tangible component (i.e., the “card” in each of claims 8 and 19, and additionally the “one or more hardware components” and connection “by means of automated data transmission techniques” in claim 19). When reassessing the patentability of Applicants’ claims, the Office is reminded of the guidance provided in M.P.E.P. §2106.01(I):

“Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claims. ... Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence nonstatutory.”

(Emphasis added)

For at least the foregoing reasons, independent claims 8 and 19, as well as related dependent claim 20, are each believed to define statutory subject matter. It is therefore respectfully requested that the rejection of these claims under 35 U.S.C. §101 be withdrawn.

Claims 8, 10, and 15-18 stand rejected under 35 U.S.C. § 102(e) as allegedly being unpatentable [sic: anticipated] by Risafi et al. (US 6,473,500 B1 -- henceforth “Risafi”). This rejection is respectfully traversed.

Independent method claim 8 has been amended to define, *inter alia*, “machine readable information on at least one of the front side and back side [of the card] ... wherein said machine readable information is not in an industry standard credit card authorization infrastructure information format whereby said machine readable information is prevented from eliciting a transaction approval in a non-authorization or pre-authorization environment, and wherein said account information indicia are in an industry standard credit card format that is capable of eliciting a transaction approval when manually entered into automated equipment.” (Emphasis added.) Support for the machine readable information not being in an industry standard credit card authorization infrastructure information format whereby said machine readable information is prevented from eliciting a transaction approval in a non-authorization or pre-authorization environment can be found in the specification at, for

example, page 17, lines 12-15. Support for the account information indicia being in an industry standard credit card format that is capable of eliciting a transaction approval when manually entered into automated equipment can be found in the specification at, for example, page 18, lines 11-18.

Independent method claim 10 has been similarly amended and has been further amended to define “using automated equipment to read the machine readable information and to use the machine readable information in a card activation procedure.” Support for this feature can be found in the specification at, for example, page 18, lines 19-27.

These features are important in the context of the invention at least because the machine readable information enables the card to be activated automatically. For example, the specification at page 18, lines 19-29 describes an exemplary embodiment in which the machine readable code 608 can be activated by means of a Retailer’s existing system and by the card issuer using its existing credit card payment system or infrastructure. However, with respect to using the card in a retail transaction, it is important to prevent the card from initiating such a retail transaction in pre-authorization or partial authorization environments, which permit the value or related account of the card to be credited prior to authorization from an Issuer (e.g., at a gas pump -- see, e.g., specification at page 17, lines 12-20). Thus, the account information that actually enables a retail transaction to occur is provided on the card only in the form of “indicia”. The user can, for example, manually input this code into equipment at authorized locations (see, e.g., specification at, for example, page 18, lines 11-18).

By contrast, none of these claimed features can be found in the cited prior art. The Office relies on Risafi only for showing that the account information indicia are at least partially different from the account data stored in the machine readable form. However, in Risafi, this “difference” appears to consist only of the addition of a “check digit” that enables the automated system to verify the accuracy of the remaining magnetically stored digits. Rather than preventing the machine readable account data from successfully initiating a retail transaction in pre-authorization or partial authorization environments, Risafi’s check digit would seem to facilitate any such attempt by verifying that the machine read data is correct.

Although dependent claims 9 and 11 were not included under this ground of rejection, the present amendment makes their respective subject matter now relevant to independent claims 8 and 10. Thus, the Office’s treatment of claims 9 and 11 is of some relevance. With respect to its rejection of claims 9 and 11, the Office rightfully acknowledges that Risafi fails

to disclose or suggest the machine readable information being in a format that is different from industry standard credit card authorization infrastructure. The Office attempts to make up for this deficiency by relying on U.S. Pub No. 2003/0028481 A1 to Flitcroft et al. (henceforth “Flitcroft”).

However, even if Flitcroft were to be considered in combination with Risafi, it would fail to include all of the claimed features that are missing in Risafi. The Office relies on Flitcroft disclosing embodiments in which “The ‘master account’ may but likely does not have the format of a standard credit card.”

However Flitcroft, like Risafi, is silent with respect to:

- said machine readable information not being in an industry standard credit card authorization infrastructure information format whereby said machine readable information is prevented from eliciting a transaction approval in a non-authorization or pre-authorization environment (independent claims 8 and 10);
- the account information indicia being in an industry standard credit card format that is capable of eliciting a transaction approval when manually entered into automated equipment (independent claims 8 and 10); and
- using automated equipment to read the machine readable information and to use the machine readable information in a card activation procedure (independent claim 10).

(Emphasis added)

Thus, even if Risafi and Flitcroft were to be considered in any combination, that combination would still fail to render either anticipated or obvious either of Applicants’ independent claims 8 and 10, or any of claim 10’s dependent claims 15-18. It is therefore respectfully requested that the rejection of these claims under 35 U.S.C. §102(e) be withdrawn.

Claims 1-7 stand rejected under 35 U.S.C. §103 (a) as allegedly being unpatentable over Smith et al. (US 7,328,190 B2 - henceforth , “Smith”) in view of Flitcroft. This rejection is respectfully traversed.

Claim 1 has been amended to define:

Claim 1 (currently amended): A method for managing at least one transaction through using credit card authorization payment infrastructures, the method comprising the steps of:

one or more automated Issuer hardware components providing a personal account number, the personal account number corresponding to an account managed by an Issuer and being in a format different from industry standard credit card number format, wherein said different format prevents the personal account number from eliciting a transaction approval in a non-authorization or pre-authorization environment;

associating the personal account number with a predetermined value;

assigning the personal account number to a stored value instrument upon activation of the stored value instrument; and

providing the stored value instrument to a Consumer,

wherein the step of providing the personal account number further comprises the one or more automated Issuer hardware components using automated data transmission techniques to provide the personal account number to one or more hardware components of a Personal Account Number (PAN) Facilitator, wherein the PAN Facilitator is a single technology supplier capable of interacting with a plurality of Issuers.

Support for the limitation “said different format prevents the personal account number from eliciting a transaction approval in a non-authorization or pre-authorization environment” can be found in the specification at, for example, page 17, lines 12-15. Support for “the step of providing the personal account number further compris[ing] the one or more automated Issuer hardware components using automated data transmission techniques to provide the personal account number to one or more hardware components of a Personal Account Number (PAN) Facilitator, wherein the PAN Facilitator is a single technology supplier capable of interacting with a plurality of Issuers” can be found in the specification at, for example, page 5, lines 6-13 and in FIG. 1.

The language of dependent claim 3 has been modified merely to accommodate the changes made to its base claim 1.

The Office acknowledges that Smith neither discloses nor renders obvious an account being in a format different from industry standard credit card number format, and relies on Flitcroft as making up for this deficiency. However, both Smith and Flitcroft are deficient in that neither one of these discloses:

- wherein said different format prevents the personal account number from eliciting a transaction approval in a non-authorization or pre-authorization environment
- the one or more automated Issuer hardware components using automated data transmission techniques to provide the personal account number to one or more hardware components of a Personal Account Number (PAN) Facilitator, wherein the PAN Facilitator is a single technology supplier capable of interacting with a plurality of Issuers.

Flitcroft's deficiency with respect to the different format preventing the personal account number from eliciting a transaction approval in a non-authorization or pre-authorization environment was discussed extensively above, and that discussion is incorporated herein by reference.

Further, Applicants' system is uniquely configured in that a separate PAN facilitator is provided that is a single technology supplier capable of interacting with a plurality of Issuers. This technological arrangement permits large business/commercial efficiencies to be achieved, but neither Smith nor Flitcroft appears to disclose the claimed distributed arrangement.

For at least the foregoing reasons, the subject matter defined by independent claim 1, as well as that defined by the related dependent claims 2-7, is believed to be patentably distinguishable over any combination of Smith and Flitcroft. It is therefore respectfully requested that the rejection of these claims under 35 U.S.C. §103(a) be withdrawn.

Claims 9 and 11-14 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Risafi in view of Flitcroft. This rejection is respectfully traversed.

The rejection of claims 9 and 11 has been rendered moot by the cancellation of these claims without prejudice or disclaimer. The respective features defined by claims 9 and 11 have been incorporated into respective ones of independent claims 8 and 10, whose patentability with respect to any combination of Risafi and Flitcroft was discussed above.

Claims 12 and 13 have been amended so that they each now depend directly from independent claim 10. Claim 13 has also been amended to correct an informality.

Claims 12-14 are believed to define subject matter that is patentably distinguishable over any combination of Risafi and Flitcroft at least for the same reasons as those set forth above, including the failure of Risafi and Flitcroft to show, either individually or in combination:

- said machine readable information not being in an industry standard credit card authorization infrastructure information format whereby said machine readable information is prevented from eliciting a transaction approval in a non-authorization or pre-authorization environment (independent claims 8 and 10);
- the account information indicia being in an industry standard credit card format that is capable of eliciting a transaction approval when manually entered into automated equipment (independent claims 8 and 10); and
- using automated equipment to read the machine readable information and to use the machine readable information in a card activation procedure (independent claim 10).

(Emphasis added)

Therefore, it is respectfully requested that the rejection of claims 12-14 under 35 U.S.C. §103(a) be withdrawn.

Claims 19 and 20 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Risafi in view of Walker et al. (US 6,193,155 B1 -- henceforth “Walker”). This rejection is respectfully traversed.

Claim 19 has been amended to define:

Claim 19 (currently amended): A system for distributing a card at retail that is redeemable at selected redemption sites, the system comprising:

 a card, the card being tangible and having a front side and back side, machine readable information on at least one of the front side and back side, the machine readable information containing account data, account information indicia on at least one of the front side and back side, the account information indicia being at least partially different from the account data, and a personal account number associated card;

 a personal account number facilitation system comprising one or more hardware components, and

 a redemption site interface, the redemption site interface being operative to connect by means of automated data transmission techniques to the personal account number facilitation system in response to using the card at a redemption site,

wherein said machine readable information is not in an industry standard credit card authorization infrastructure information format whereby said machine readable information is prevented from eliciting a transaction approval in a non-authorization or pre-authorization environment,

wherein said account information indicia are in an industry standard credit card format that is capable of eliciting a transaction approval when manually entered into automated equipment, and

wherein the personal account number facilitation system is a single technology supplier of personal account numbers to retailers.

(Emphasis added.)

Support for the machine readable information not being in an industry standard credit card authorization infrastructure information format whereby said machine readable information is prevented from eliciting a transaction approval in a non-authorization or pre-authorization environment can be found in the specification at, for example, page 17, lines 12-15.

Support for the account information indicia being in an industry standard credit card format that is capable of eliciting a transaction approval when manually entered into automated equipment can be found in the specification at, for example, page 18, lines 11-18.

Support for the personal account number facilitation system being a single technology supplier of personal account numbers to retailers can be found in the specification at, for example, page 5, lines 6-13 and FIG. 1.

Independent claim 19 is believed to define subject matter that is patentably distinguishable over any combination of Risafi and Walker at least because no combination of those documents discloses:

- A system ... wherein said machine readable information is not in an industry standard credit card authorization infrastructure information format whereby said machine readable information is prevented from eliciting a transaction approval in a non-authorization or pre-authorization environment,
- wherein said account information indicia are in an industry standard credit card format that is capable of eliciting a transaction approval when manually entered into automated equipment, and

- wherein the personal account number facilitation system is a single technology supplier of personal account numbers to retailers.

The deficiencies of Risafi with respect to the machine readable information not being in an industry standard credit card authorization infrastructure information format whereby the machine readable information is prevented from eliciting a transaction approval in a non-authorization or pre-authorization environment were discussed above, and acknowledged by the Office. Neither the Walker document nor any of the other documents cited by the Office in connection with the other grounds of rejection makes up for this deficiency of Risafi.

Furthermore, it is believed that neither Risafi nor Walker discloses the personal account number facilitation system being a single technology supplier of personal account numbers to retailers. As explained above, this unique distributed system enables large business/commercial efficiencies to be achieved.

For at least the foregoing reasons, independent claim 19 and its related dependent claim 20 are each believed to define subject matter that is patentably distinguishable over the prior art of record. Therefore, it is respectfully requested that the rejection of these claims under 35 U.S.C. §103(a) be withdrawn.

The application is believed to be in condition for allowance. Prompt notice of same is respectfully requested.

Respectfully submitted,
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